

REMARKS

At the time of the Office Action dated July 30, 2007, claims 1-15 were pending and rejected in this application. Independent claim 1 has been amended to include the limitations previously presented in claims 2-3 and 5. Independent claim 6 has been amended to include the limitations previously presented in claims 7 and 9. Independent claim 11 has been amended to include the limitations previously presented in claims 12 and 14. Claims 2-5, 7-10, and 12-14 have been cancelled. Applicant submits that the present Amendment does not generate any new matter issue.

CLAIMS 1-5 AND 15 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 2 and 3 of the Fourth Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-5 and 15, is directed to non-statutory subject matter. This rejection is respectfully traversed.

In the paragraph spanning pages 2 and 3 of the Fourth Office Action, the Examiner asserted the following:

Regarding independent claim 1, the claim describes a system but fails to include any hardware elements in the system such as a CPU. Instead the claims describe the use of a system for a client device, it is unclear since the system is merely steps that may be used by a device only if it was embodied in a computer readable medium. If the system is directed to software it should be embodied inside a computer readable medium, if for hardware it should recite a hardware element in the claims such as a processor. A validation processor is not an actual hardware element. Furthermore a system that can be used for client devices is not sufficient because the system itself is not tangibly embodied in a computer readable medium to be used by anything. Appropriate corrections are required.

Applicant respectfully submit that the Examiner's analysis is fatally flawed. Specifically, the Examiner is directed to the recent decision of the Federal Circuit of In re Comiskey.¹ Although the Court held that several claims were directed to non-statutory subject matter, the Court determined that certain other of the claims were directed to statutory subject matter. In determining the latter, the Court stated the following:

These claims, under the broadest reasonable interpretation, could require the use of a computer as part of Comiskey's arbitration system. (emphasis added)

Thus, the Court determined that the claims are not required to necessarily include or require a computer. Instead, the Court concluded that the claims meet the requirements of 35 U.S.C. § 101 if, under a broadest reasonable interpretation, the claims could require the use of statutory subject matter (e.g., a computer, a device, a product, etc.). As is readily apparent from Applicant's disclosure, a validation processor could require the use of a computer device. Therefore, for the reasons stated above, Applicant respectfully solicits withdrawal of the imposed rejection of claims 1 and 15 under 35 U.S.C. § 101.

**CLAIMS 1-15 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
DZIEJMA, U.S. PATENT PUBLICATION NO. 2005/0028084, IN VIEW OF SOKOLOV, U.S. PATENT
NO. 6,823,504**

On pages 3-12 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Dziejma in view of Sokolov to arrive at the claimed invention. This rejection is respectfully traversed.

¹ Appeal No. 2006-1286.

At the outset, Applicant notes that the Examiner has failed to clearly designate the teachings in both Dziejma and Sokolov being relied upon the statement of the rejection as required by 37 C.F.R. § 1.104(c).² Instead, the Examiner treats the claimed invention with a broad brush without considering the individual claimed elements.

Applicant also notes that the filing date of the present application is November 13, 2003, whereas the filing date of Dziejma is July 27, 2004. Therefore, the Examiner cannot rely upon the disclosure of Dziejma, but instead, the Examiner must be relying upon the disclosure in U.S. Provisional Application No. 60/490,590 (hereinafter the '590 provisional application), upon which Dziejma claims priority, since the filing date for the '590 provisional application is July 28, 2003, which is prior to the filing date of the present application. As stated in M.P.E.P. § 2136.03(III), entitled "PRIORITY FROM PROVISIONAL APPLICATION UNDER 35 U.S.C. 119(e)":

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. (emphasis added)

Thus, the Examiner must establish that the '590 provisional application supports the subject matter being relied upon to make the rejection. This burden, however, has not been met.

At the outset, Applicant notes that independent claim 1 has been amended to include the limitations previously presented in claims 2-3 and 5; independent claim 6 has been amended to

² 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

include the limitations previously presented in claims 7 and 9; and independent claim 11 has been amended to include the limitations previously presented in claims 12 and 14. However, upon reviewing the Examiner's analysis for dependent claims 2-3, 5, 7, 9, 12 and 14, it appears that the Examiner has "cut and paste" the same analysis regarding independent claims 1, 6, and 11 without ever addressing the limitations of the dependent claims. Thus, the Examiner has failed to establish a prima facie case of obviousness regarding these claims.

Notwithstanding the Examiner's failure to set forth any analysis regarding the dependent claims, the applied prior art fails to teach the limitations recited therein. Specifically, independent claims 1, 6, and 11 each include the concept that the functional calls are encapsulated within a validation shell of markup, which is illustrated in Fig 2 and described in paragraphs [0021] and [0022] of Applicant's disclosure. These features are neither taught nor suggested by the '590 provisional application.

Applicant also disagrees with the Examiner's asserted rationale for modifying Dziejma in view of Sokolov. Specifically, the Examiner asserted the following in the paragraph spanning pages 3 and 4 of the Fourth Office Action:

Although Dziejma teaches the use of JavaScript in the FVE, he only shows function calls defined within the engine and fails to show reference to a separate library objects referenced by JavaScript. However Sokolov explicitly teaches the use of libraries which are interfaced with JavaScript (see abstract). Thus at the time of the invention it would have been obvious to the skilled artisan to have modified the script definitions of Dziejma to include reference to various JavaScript libraries has taught by Sokolov. The motivation for doing so would have been to provide extensibility to the validation engine by referencing libraries of scripting objects in JavaScript without constantly accessing a server, thus improving form validation on client devices. (emphasis added)

The problem allegedly solved by Sokolov is to provide extensibility to the validation engine without constantly accessing a server. However, Dziejma does not teach that the validation engine requires additional access to the server for extensibility. Instead, it appears that the

validation engine of Dziejma, when originally received from the server, includes all the necessary functions and does not have to go back to the server (see paragraph [0012] of Dziejma). Thus, the problem allegedly solved by Sokolov is already addressed by Dziejma, and based upon common sense, one having ordinary skill in the art would not look to solve a problem that is already solved.³

Claim 15

Regarding claim 15, the Examiner relied upon Fig. 1 of Dziejma. Notwithstanding that Dziejma cannot be properly relied upon (instead, the Examiner must be relying upon the '590 provisional application to support the rejection), Dziejma does not teach using a pervasive device. Instead, Dziejma merely describes a server 410 and a client 420, which is not the disclosure of a pervasive device.

Therefore, for the reasons stated above, Applicant respectfully solicits withdrawal of the imposed rejection of claims 1, 6, 11, and 15 under 35 U.S.C. § 103 for obviousness based upon Dziejma in view of Sokolov.

³ See the non-precedential opinion of Ex parte Rinkevich, Appeal 2007-1317 ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: October 30, 2007

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